

Office Action Summary

Application No.

10/829,145

Applicant(s)

WU, YUH-CHERNG

Examiner

BORIS PESIN

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10-13 and 15 is/are rejected.
- 7) ☒ Claim(s) 4, 9 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This communication is responsive to the appeal brief filed 10/19/2009.

Claims 1-15 are pending in this application. Claims 1, 6 and 11 are independent claims. This action is made Non-Final.

In view of the appeal brief filed on 10/19/2009, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/DENNIS-DOON CHOW/
Supervisory Patent Examiner, Art Unit 2174

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-8, and 10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Bennett et al. (US 6782518).

Re claim 1, Bennett teaches a method to be executed as part of a process for creating an executable configuration program that comprises multiple steps that are successively executed and wherein associated with each of the steps are user-selectable options, the method comprising: generating a user interface including at least (i) a logic flow area for a user to define a command structure for the configuration program including at least one step (See Figure 3), (ii) a refinement area for the user to specify a configuration detail regarding a step arranged in the logic flow area (See Figure 7, element 700), and (iii) a rule palette for the user to create a rule, wherein the rule palette provides multiple conditional operators and entry fields (See Figure 4, Element 404); creating and storing in a repository the rule that during execution of the configuration program determines which of the user-selectable options for the step are

displayed when a specified user-selectable option of a previous step is selected (See Element 8 Element 800 which shows the relationship between elements and how one element affect another), wherein the step and the previous step are arranged in the logic flow area and the user specifies the rule in the refinement area (See Figure 11, Element 902); and binding the rule in the repository to the specified user-selectable option so that during execution of the configuration program the rule is executed when the specified user-selectable option is selected (See Figure 10, Element 926 which shows that an action is performed when the option is selected).

Re claim 2, Bennett teaches a method wherein the binding of the rule to the specified user-selectable option is performed by virtue of a designer selecting a user-selectable option for which to create the rule (inherent, since a user can name the beans with any desired name).

Re claim 3, Bennett teaches a method further comprising: creating a textual explanation of the step that describes available user-selectable options for the step; and binding the textual explanation to the step so that during execution of the configuration program the textual explanation of the step is displayed (See Figure 11, element 904, the ticker tape contains text which explains).

Claims 6-8 are similar in scope to claims 1-3; therefore they are rejected under similar rationale.

Claims 11-13 are similar in scope to claims 1-3; therefore they are rejected under similar rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of SAP Wizard Builder (NPL provided by the applicant in IDS called Screen Shots of a Wizard Builder sold by SAP AG, 7 sheets).

Re claim 5, Bennett teaches all the limitations of claim 1. Bennett does not specifically teach note a method further comprising evaluating the stability of a configured software application by executing the software application using a simulated user-selectable option. SAP Wizard Builder discloses a method further comprising evaluating the stability of a configured software application by executing the software application using a simulated user-selectable option (see page 3, execute in diagnosis

mode for example). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bennett with the teachings of SAP and include the ability to test the software and make certain that a user will have a stable and bug free environment to use.

Claims 10 and 15 are similar in scope to claim 5; therefore they are rejected under similar rationale.

Allowable Subject Matter

Claims 4, 9, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments, see pages 7-10, filed 10/19/2009, with respect to the rejection(s) of claim(s) 1-15 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bennett et al..

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5831611 Kennedy et al.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BORIS PESIN whose telephone number is (571)272-4070. The examiner can normally be reached on Monday-Friday except every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on (571)272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Boris Pesin/
Primary Examiner, Art Unit 2174